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500.33021CX5

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicant(s): T. NINOMIYA, et al

Serial No.: 09/933,805

Filed: August 22, 2001

For: STORAGE SYSTEM HAVING DATA FORMAT CONVERSION  
FUNCTION (Amended)

Group: 2186

Examiner: H. Patel

**PETITION TO WITHDRAW THE PREMATURE FINALITY OF  
AN OFFICE ACTION UNDER 37 CFR §1.81**

**MS Petition**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

February 22, 2005

Sir:

The present Petition is being filed to request that the finality of the February 11, 2005 Office Action be withdrawn as being premature in accordance with MPEP 708.07(b).

**STATEMENT OF FACTS**

On September 22, 2004 a final Office Action was mailed rejecting claims 21, 23, 24, 26, 27, 29-32, 37-40, 46, 47, 52 and 53 under 35 USC §103(a) as being unpatentable over Hashemi (U.S. Patent No. 5,337,414) in view of Nakamura (U.S. Patent No. 5,388,013); and rejecting claims 36 and 50 under 35 USC §103(a) as

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being unpatentable over Hashemi in view of Nakamura and further in view of Dixon (U.S. Patent No. 4,637,024). In response to the September 22, 2004 Office Action an Amendment after final was filed on December 22, 2004 which made various amendments to the independent claims and argued the differences between the amended claims and the references of record.

In response to the December 22, 2004 Amendment an Advisory Action was issued on January 6, 2005 in which the Examiner checked Box 2 and its sub-box (a) thereby indicating that the "proposed amendment will not be entered because: they raise new issues that would require further consideration and/or search". However, the Examiner also checked Box 7 and its sub-box (b) thereby indicating that "for purposes of appeal, the proposed amendment will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended".

After the Advisory Action, the application was not appealed to the Board. Applicants filed a Request for Continued Examination (RCE) on January 21, 2005 wherein as part of the RCE the submission included entry of the December 22, 2004 Amendment after final and an Information Disclosure Statement filed on January 21, 2005.

In response to the RCE, the Examiner issued an Office Action on February 11, 2005 in which the Examiner made the Office Action final and asserted that "all claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of the record in the next Office Action if they had been entered in the earlier application".

## **POINTS TO BE REVIEWED**

The finality of the February 11, 2005 Office Action was premature being that MPEP 706.07(b) specifically states that:

“it would not be proper to make final a first Office Action in a continuing or substitute application where that application contains material which was presented in the earlier application after final rejection or close of prosecution was but denied entry because (A) new issues were raised that would require further consideration and/or search, or (B) the issue of new matter was raised”.

In the January 6, 2005 Advisory Action, the Examiner specifically checked Box 2 and its sub-box (a) denying entry of the December 22, 2004 Amendment on the grounds that the Amendment “raise new issues that would require further consideration and/or search”. The Examiner also checked Box 7 and its sub-box (b). However, the conditional entry of the December 22, 2004 Amendment was only “for purposes of appeal”. No such appeal was taken from the September 22, 2004 Office Action. Therefore, the condition was never met and as such the amendments were never entered, which was the clear intent of the Examiner by checking both of Boxes 2 and 7.

In the Office Action the Examiner alleges that all claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office Action if the had been entered in the earlier application. This allegation by the Examiner is completely self-serving being that the Examiner specifically checked Box 2 and its sub-box (a) thereby agreeing that the amendments raise new issues that would require further

consideration and/or search and as such could not have been rejected by the art of record or the arguments of record in the prior final Office Action.

Therefore, Applicants submit that the finality of the February 11, 2005 Office Action is premature and should be withdrawn.

**ACTION REQUESTED**

Applicants hereby request that the Supervisory authority of the Director be invoked to withdraw the finality of the February 11, 2005 Office Action.

To the extent necessary, the applicants petition for an extension of time under 37 CFR 1.136. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, or credit any overpayment of fees, to the deposit account of MATTINGLY, STANGER, MALUR & BRUNDIDGE, P.C., Deposit Account No. 50-1417 (500.33021CX5).

Respectfully submitted,

MATTINGLY, STANGER, MALUR & BRUNDIDGE, P.C.



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